



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,588	03/30/2001	S. Sean Moore	UV/192	6830

1473 7590 06/22/2006

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK, NY 10020-1105

EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,588

Applicant(s)

MOORE ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-18,20-37,40-43,45-48 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-18,20-37,40-43,45-48 and 50-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 6-18, 20-37, 40-43, 45-48 and 50-53 have been examined. Application 09/823,588 (SYSTEM AND METHOD FOR METADATA-LINKED ADVERTISEMENTS) has a filing date 03/30/2001.

Response to Amendment

2. In response to Non Final Rejection filed 12/15/2005, the Applicant files an Amendment on 04/17/2006, which amended claims 1, 18, 32, 36, 37, 48 and 53.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 6-18, 20-34, 37, 40-43, 45-48 and 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al (U.S. 6,357,042).

Art Unit: 3622

As per claims 1, 18, 32, 36, 37, 43, 48 and 53, Srinivasan teaches:

A method executed by at least one computer processor for providing metadata-selected advertisements, comprising:

receiving media comprising at least one object, metadata associated with the object and containing a description of the object, and metadata associated with a plurality of advertisements *related to the object* (see column 5, line 62 – column 6, line 19; column 6, lines 10-18 “advertisements, may for example, be associated with a tracked object”; column 32, lines 22-30);

displaying the media and the object on a viewing device (see column 7, lines 37-49);

receiving a user selection of the object displayed on the viewing device (see column 32, line 21 – column 33, line 3);

processing metadata associated with the object selected by the user (see column 32, line 21 – column 33, line 3);

comparing the metadata associated with the object selected by the user with the metadata associated with the plurality of advertisements *related to the object* (see column 6, lines 8-20; column 7, lines 32-48; column 12, lines 21-32; column 32, line 21 – column 33, line 3; column 36, lines 10-25; column 37, lines 1-8); and

selecting *one of the plurality of advertisements* related to the object based on the comparison (see column 6, lines 9-19; column 7, lines 32-50; column 12, lines 20-34; column 31, lines 35-65; column 32, lines 22-40)

Art Unit: 3622

monitoring the selected advertisement (see column 7, lines 35-49; column 31, line 36 – column 57);

collecting data on the selected advertisement (see column 7, lines 36-49), recording the data and downloading the selected advertisement and displaying the selected advertisement (see column 31, lines 47-64).

As per claim 2, Srinivasan teaches:

The method of claim 1 further comprising displaying the selected advertisement on the viewing device (see column 12, lines 20-35; column 32, lines 21-64).

As per claims 6, 20, 40, 45 and 50, Srinivasan teaches:

The method of claim 1 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 7, 21, 41, 46 and 51, Srinivasan teaches:

The method of claim 1 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56).

As per claims 8, 22, 42, 47 and 52, Srinivasan teaches:

The method of claim 1 further comprising storing the metadata associated with the object and the metadata associated with the plurality of advertisements (see column 32, lines 21-31).

As per claims 9 and 23, Srinivasan teaches:

The method of claim 8 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements are stored on a single storage device (see figure 16; column 32, lines 21-31).

As per claims 10 and 24, Srinivasan teaches:

The method of claim 8 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements are stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claims 11 and 25, Srinivasan teaches:

The method of claim 1 further comprising receiving the selected advertisement (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 12 and 26, Srinivasan teaches:

The method of claim 11 wherein the selected advertisement is received within the media (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 13 and 27, Srinivasan teaches:

The method of claim 11 wherein the selected advertisement is received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 14 and 28, Srinivasan teaches:

The method of claim 11 wherein the selected advertisement is received on a separate broadcast channel from the media (see column 31, lines 15-56).

As per claims 15 and 29, Srinivasan teaches:

The method of claim 1 further comprising storing the selected advertisement (see column 32, lines 21-55).

Art Unit: 3622

As per claims 16 and 30, Srinivasan teaches:

The method of claim 15 wherein the selected advertisement is stored on a single storage device (see figure 16, column 32, lines 21-31) .

As per claims 17 and 31, Srinivasan teaches:

The method of claim 15 wherein the selected advertisement is stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claim 33, Srinivasan teaches:

The method of claim 32 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements further contain a source address (see column 32, lines 21-40).

As per claim 34, Srinivasan teaches:

The method of claim 33 wherein the source address is a Uniform Resource Locator (see column 32, lines 21-40).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (U.S. 6,357,042).

Art Unit: 3622

As per claim 35, Srinivasan does not expressly teach:

The method of claim 33 wherein the source address is a telephone number. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Srinivasan would include in the source address the advertiser's telephone number therefore giving users the advertiser's contact information.

Response to Arguments

5. Applicant's arguments filed 04/17/2006 have been fully considered but they are not persuasive. The Applicant argues that that the Examiner agreed in telephone Interview filed 04/17/2006, that the proposed amendments were patentable over the prior art. The Examiner answers that the Examiner mentioned in said Interview that he needed to wait for the Applicant's response to determine how to proceed.

The Applicant argues that in Srinivasan, when a user selects an object, only the lone advertisement connected to the hyperlink associated with that object is selected and according to the Applicant, this is contrary to Applicant's claimed invention, where there is a pool of advertisements from an advertisement can be selected when a object is selected.

The Examiner answers that the Applicant needs to point out where in the Applicant's specification is taught the limitation of pooling advertisements. Applicant's specification page 14 recites "metadata may contain a source address (e.g. URL) to download an advertisement from a remote location...The advertisement that is presented to a viewer may be the advertisement currently available at the source".

Art Unit: 3622

Therefore, contrary to Applicant's argument, in Applicant's claimed invention, also the lone advertisement connected to the hyperlink associated with that object is selected. Furthermore, Srinivasan teaches a system that allows viewers to access advertisements or other data which may be associated with individual entities, where advertisements (i.e. plural term) may be associated with a tracked object¹. Also, Srinivasan teaches inserting a plurality of metadata (i.e. URLs of ads) into a video stream, where a playback unit at the clients station makes use of the inserted metadata to pull the relevant ad or ads from the appropriate destinations in the Internet². Therefore, contrary to Applicant's argument, Srinivasan teaches a pool of advertisements from which an advertisement can be selected.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

¹ Srinivasan column 6, lines 10-17

Art Unit: 3622


Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
June 5, 2006



RETTA YEHDEGA
PRIMARY EXAMINER

² Srinivasan column 32, lines 22-40